

REMARKS

Claims 1-15 are pending in this application.

Allowed Subject Matter

Applicants appreciate the Examiner's prompt allowance of claims 1-7, 9-11, and 13-15. Applicants' response to the rejection of claims 8 and 12 is set forth below.

Rejection Under 35 U.S.C. § 103

Applicants respectfully request reconsideration of the rejection of claims 8 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Shiota et al.* ("Shiota") (US 6,011,547) in view of Applicants' allegedly admitted prior art ("the APA"). As will be explained in more detail below, the combination of the *Shiota* reference in view of the APA would not have suggested to one having ordinary skill in the art the subject matter defined in independent claims 8 and 12.

Independent claim 8 (a method claim) and independent claim 12 (an apparatus claim) specify the following features:

- a) the shooting information and the image processing control information are associated with image data by the image data generating apparatus; and
- b) the image data generating apparatus and the image processing apparatus are separate bodies.

In formulating the obviousness rejection of claims 8 and 12, the Examiner asserts that the *Shiota* reference discloses the above-listed features a) and b). Applicants respectfully traverse the Examiner's characterization of the *Shiota* reference relative to the subject matter defined in claims 8 and 12. If the *Shiota* reference is considered to disclose feature b), then the *Shiota* reference necessarily fails to disclose feature a). As will be explained in more detail below, if the *Shiota* reference is consistently characterized relative to the claimed

subject manner, then the *Shiota* reference cannot reasonably be considered to disclose both features a) and b).

In support of the obviousness rejection, the Examiner relies on *Shiota*'s digital still camera and image reproducing apparatus as corresponding to the claimed image data generating apparatus and the claimed image processing apparatus, respectively. With this characterization, the *Shiota* reference fails to disclose feature a) for the following reasons. First, while *Shiota*'s digital still camera is capable of associating image data with shooting information, it is *incapable* of associating image data with an image processing condition. The *Shiota* reference explicitly states that the image reproducing apparatus generates an image processing condition based on the recording information, and associates the image processing condition with the image data (see column 5, lines 54-67).

Accordingly, if *Shiota*'s digital camera and image reproducing apparatus are interpreted as corresponding to the claimed image data generating apparatus and the claimed image processing apparatus, respectively, then the *Shiota* reference fails to disclose or suggest at least feature a) specified in claims 8 and 12.

Second, regardless of whether *Shiota* is considered to disclose feature b), the *Shiota* reference does not provide any disclosure or suggestion of feature a).

Third, *Shiota*'s configuration allows an image processing condition to be generated according to an algorithm *owned by the image reproducing apparatus*. Therefore, the *Shiota* reference neither discloses nor suggests the technical concept of controlling an image processing condition in the image reproducing apparatus.

The APA relied upon by the Examiner does not cure the above-discussed deficiencies of the *Shiota* reference relative to features a) and b). Thus, even if one having ordinary skill in the art were to combine *Shiota* and the APA in the manner proposed by the Examiner, the result of this combination would not have included each and every feature of the subject

matter defined in claims 8 and 12. As such, the combination of *Shiota* in view of the APA would not have rendered the subject matter defined in claims 8 and 12 obvious to one having ordinary skill in the art.

Accordingly, for at least the foregoing reasons, independent claims 8 and 12 are patentable under 35 U.S.C. § 103(a) over the combination of *Shiota* in view of the APA.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 8 and 12, and submit that these claims are in condition for allowance, along with allowed claims 1-7, 9-11, and 13-15. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP073).

Respectfully submitted,
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